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<u>**Grounds of Rejection to be reviewed On Appeal**</u>

I. Whether claims 6, 23, 25, 27 and 29-32 are anticipated under 35 USC 102(e) by Medvinsky (US Patent 6,754,908), **II.** Whether claim 7 is unpatentable under 35 USC 103(a) over Medvinsky in view of Nobakht et al. (US Patent 7,111,051), and **III.** Whether claims 8 and 28 are unpatentable under 35 USC 103(a) over Medvinsky in view of Moroney (US Patent 6,532,593).

<u>**Argument**</u>

I.   Rejection of Claims 6, 23, 25, 27, and 29-32 under 35 U.S.C. § 102(e)

   A. Medvinsky fails to disclose all of the recitations of claims 6 and 23

Claims 6 and 23 include multiple recitations that are not disclosed by Medvinsky. These claims include recitations to comparing information about parameters of the STB to information about expected parameters of the STB and doing so remotely from the STB. These claims also include recitations about sending an instruction to the STB to change parameters where that instruction is sent from a remote location. Medvinsky does not account for these recitations.

   1.   Medvinsky fails to show a comparison of a first item of information about parameters of an STB to a second item of information about expected parameters occurring remotely from the STB

Claims 6 and 23 specifically recite that a comparison is done between a first item of information pertaining to STB parameters and a second item of information pertaining to expected STB parameters and that the comparison is done remotely from the STB. This is supported in the specification by offering examples whereby the service provider 102 obtains the first information from the STB and the second information from a database and compares the two. Medvinsky simply does not do such a remote comparison.

The final Office Action cites to Medvinsky's abstract, column 1 lines 54-column 2, lines 14, and column 7 line 32-column 8 line 67. None of these citations or any other disclosure of Medvinsky provides for a comparison of the first item and the second item that occurs remotely from the STB. Furthermore, the final Office Action has offered no insight as to how these citations could possibly be a disclosure of the claim recitations involving the comparison occurring remotely from the STB.

The Advisory Action attempts to address this argument that was presented in the after final response. However, the Advisory Action sheds light on the faulty rejection. In part A) of the Advisory Action's explanation, the recitations regarding the comparison occurring remotely from the STB are entirely ignored. The Advisory Action concludes that to find that the STB has been hacked

that a comparison must be performed. However, that conclusion is simply not adequate to address a claim that recites that the comparison occurs remotely from the STB. The Final Office Action and the Advisory Action should have given weight to the recitations regarding the comparison occurring remotely from the STB but simply do not do so. That is clear error that should be reversed on appeal by withdrawing the rejection of claims 6 and 23. It was Applicant's expectation that the Notice of the Panel Decision would recognize this issue and withdraw the rejection, but the rejection was inexplicably sustained without further comment.

Upon giving consideration to all of the recitations rather than ignoring that the comparison is occurring remotely from the STB, one can see that Medvinsky does not disclose a comparison of the first information to the second information at a location remote from the STB. To the contrary, at best the STB may do some comparison when the STB makes a decision about whether the STB has its security hacked at operations 616, 716, 816, and 916 of FIGs 6-9. The headend, which would be remote from the STB, concludes that the STB is hacked NOT by comparing first and second information but instead by either receiving or not receiving an error report from the STB (see for example, items 620 and 624 versus items 628 and 632 of FIG. 6). Therefore, one must conclude that Medvinsky fails to disclose all of the recitations of claims 6 and 23 such that this rejection should be withdrawn.

2. Medvinsky fails to show an instruction being sent from a remote location to the STB as a result of the comparison

Claims 6 and 23 also include recitations to an instruction being sent from a remote location to the STB as a result of the comparison. Medvinsky also fails to disclose these recitations.

The final Office Action again cites to the same passages of Medvinsky, namely, the abstract, column 1 lines 54-column 2, lines 14, and column 7 line 32-column 8 line 67. Again, the final Office Action offers no insight as to how these passages disclose that an instruction is sent as a result of the comparison that has allegedly taken place. Note that the comparison itself has been disputed above by Applicant.

The Advisory Action attempts to address this in part B) by saying that because Medvinsky discloses detecting a malfunction and then stopping services, that a command or instruction must be communicated. This conclusion, like the one previously discussed above, ignores the claim recitations. Claims 6 and 23 do not merely state that a problem is detected and that services are stopped. These claims recite that an instruction is sent from the location remote from the STB to the STB based on a result of the act of comparing. For purposes of this argument, it is not even necessary

to consider that the act of comparing is recited as occurring remotely from the STB. Regardless of where the comparing has occurred, the communication of the instruction from the remote location to the STB is based on that comparing. Thus, this instruction is not sent just in case an upcoming comparison later reveals something but is a communication based on the result of the comparing.

Medvinsky, on the other hand, discloses that the set top box may be manipulated by disrupting it via a Trojan Horse that has been sent as part of the request to the STB to check for hacked security. This can be seen at items 808, 812, and 840 as well as at items 908, 912, and 948. It should be noted that the headend concluding that the STB is malfunctioning at items 836 and 944 has no relation to the activation of the Trojan Horse. In other words, once the Trojan Horse has been sent by the headend, which occurs in advance of the hacked security determination, the Trojan Horse activates without further intervention by the headend. Thus, the Trojan Horse is NOT being communicated based on the result of comparing. To the extent there is any comparing, it occurs by the STB after the Trojan Horse has already been received by the STB. Therefore, it is not permissible to view the Trojan Horse as an instruction that is sent based on the result of the act of comparing.

At the passage at column 8, lines 65-67 of Medvinsky, which is discussing the embodiment of FIG. 7 that does not introduce the Trojan Horse for disruption, it is stated that after further tests the headend could take steps to stop operation of the STB. Applicant asserts that this statement is also inadequate to reject claims 6 and 23. This statement is far from disclosing that an instruction is communicated based on the result of the comparing because it is not explained what the "further tests" and the "steps to stop operation" might be. It is quite possible that Medvinsky would utilize the Trojan Horse procedure of FIGS 8 and 9 to achieve the stop operation, whereby the Trojan Horse would activate after having filtered through the security hack procedure and thus be after that comparison rather than being based upon it.

Thus, claims 6 and 23 are allowable over Medvinsky for these additional, yet independent reasons.

B. Medvinsky fails to disclose all of the recitations of claims 25, 27, and 29-32

Claims 25, 27, and 29-32 include multiple recitations that are not disclosed by Medvinsky. These claims include recitations to comparing information about parameters of the STB to information about expected parameters of the STB and doing so remotely from the STB, much like claim 6 discussed above. These claims also include recitations about retrieving the second information from a database spaced from the STB. Medvinsky fails to disclose these recitations.

1. **Medvinsky fails to show a comparison of a first item of information about parameters of an STB to a second item of information about expected parameters occurring at a computing device other than the STB**

Claims 25, 27, and 29-32 include recitations much like those of claims 6 and 23 regarding comparing the first information to the second information and doing so at a location that is remote from the STB. Claim 25 refers to a computer readable medium that causes a computer to perform various acts. That computer performing those acts is to be distinguished from the STB itself, which is clearly referred to as the STB in these claims. One of the acts being performed by the computer is to compare the first item of information to the second item of information. Thus, it is this computer performing the comparison as opposed to the STB that has provided the first item of information.

With this context being established for claims 25, 27, and 29-32, the same argument applied above in section A.1. can be applied here as well. The final Office Action and Advisory Action present the same rejection and citations to Medvinsky as was done for claims 6 and 23. Without repeating the argument for claims 6 and 23, it should be equally conclusive here that because Medvinsky is not doing any such comparing at the headend, and that if any comparing is being done it would be at the STB during the hacked security procedure, that Medvinsky fails to disclose a computer other than the STB that compares the first item of information to the second item of information.

Therefore, Applicant asserts that the rejection to claims 25, 27, and 29-32 should be withdrawn for at least these reasons.

2. **Medvinsky fails to show that a second item of information being used in the comparison is retrieved from a database that is spaced from the STB**

Claims 25, 27, and 29-32 also recite that the computer performs the act of retrieving a second item of information from a database spaced from the STB, wherein the second item of information relates to an expected configuration of the STB. Medvinsky fails to disclose these recitations as well.

The Final Office Action cites to exactly the same passages of Medvinsky, namely, the abstract, column 1 lines 54-column 2, lines 14, and column 7 line 32-column 8 line 67. The Final Action goes on to state, in what would appear to be an attempt at relating these passages to these claim recitations, that "Medvinsky discloses determining if there are any error[*sic*] or improper operation[*sic*] in [*sic*] STB." Applicant does not understand why this statement that Medvinsky determines if there are errors or improper operations occurring at the STB has any relevance to

whether a computer other than the STB of Medvinsky retrieves the second information from a database spaced from the STB, and Applicant contests that the cited passages disclose these claim recitations.

Although Applicant's after final response specifically included the argument that Medvinsky does not disclose that the second information is retrieved from a database spaced from the STB (see response filed April 29, 2007, page 8, lines 6-7), the Advisory Action leaves this argument by Applicant completely unaddressed and the Panel Decision inexplicably maintains the rejection. Thus, Applicant is unable to address any counter argument as none has been given.

Medvinsky simply does not retrieve any such second information from a database spaced from the STB. As has previously been stated, at best Medvinsky might perform some comparison during the hacked security procedure but even that is an entirely internal process to the STB once the incoming communication from the headend is received. So, even if that was construed to be a comparison involving such second information, there is no disclosure that any of the information comes from a database spaced from the STB and to the extent the STB might retrieve information from itself, that is not a computer that is distinct from the STB retrieving such second information.

Thus, for at least these additional and independent reasons, Applicant asserts that the rejection of claims 25, 27, and 29-32 should be withdrawn.

II. Rejection of Claim 7 under 35 U.S.C. § 103(a)

A. Medvinsky in combination with Nobakht fails to disclose all of the recitations of claim 7

Claim 7 depends from claim 6. The Office Actions have not attempted to address any of the previously discussed deficiencies of Medvinsky noted above in relation to claim 6 by introducing Nobakht. Applicant asserts that Nobakht does not address those deficiencies. As such, the combination of Medvinsky in view of Nobakht fails to account for the claim recitations of claim 7 for the same reasons that Medvinsky fails to account for the claim recitations of claim 6 such that claim 7 is not obvious. Thus, Applicant asserts that the rejection of claim 7 should be withdrawn for at least these reasons.

III. Rejection of Claims 8 and 28 under 35 U.S.C.. § 103(a)

A. Medvinsky in combination with Moroney fails to disclose all of the recitations of claims 8 and 28

Claim 8 depends from claim 6 while claim 28 depends from claim 25. The Office Actions have not attempted to address any of the previously discussed deficiencies of Medvinsky noted above in relation to claims 6 and 25 by introducing Moroney. Applicant asserts that Moroney does not address those deficiencies. As such, the combination of Medvinsky in view of Moroney fails to account for the claim recitations of claims 8 and 28 for the same reasons that Medvinsky fails to account for the claim recitations of claims 6 and 25 such that claims 8 and 28 are not obvious. Thus, Applicant asserts that the rejection to claims 8 and 28 should be withdrawn for at least these reasons.